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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055064
Party	Plaintiff Y.P. Golan Trade Ltd.
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Submission	Opposition/Response to Motion
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Date	03/29/2012
Attachments	OppositiontoStay.pdf (8 pages)(117193 bytes) Exhibits A-B.pdf (10 pages)(250408 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Y.P. GOLAN TRADE LTD.)	
)	
Petitioner,)	
)	
vs -)	Cancellation No. 92055064
)	[Registration Nos. 3,478,807;
)	3,684,910; 3,684,909]
MOROCCANOIL, INC.)	
)	
Respondent)	
)	

PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO SUSPEND

Petitioner, Y.P. GOLAN TRADE LTD., ("YPGT") by and through its undersigned counsel, hereby opposes Respondent's Motion to Suspend. Respondent's motion should be denied because (1) the Trademark Trial and Appeals Board is the most appropriate forum under the Primary Jurisdiction Doctrine to determine issues of genericism, merely descriptive, deceptively misdescriptive, geographically misdescriptive descriptive, and fraud; and (2) there is no other forum or opportunity for the parties to conduct discovery as to the above issues as the discovery cut-off period has past in the federal litigation and thus the TTAB provides on the only venue for the efficient and fair resolution of the disputed issues.

I. Background of the Matter

The Respondent has muddy waters in its Motion to Suspend by introducing and discussing several issues that are not simply relevant to a request for a Motion to

Suspend. To clarify the matter, Petitioner provides this brief background as follows. Respondent, Moroccanoil, Inc., received issuance of Registration Nos. 3,478,807, 3,684,910; 3,684,909 in connection with its alleged claim to trademark rights of the term "Moroccan Oil". In each of the above referenced applications, an office action was received requesting a disclaimer requirement to the entire term "Moroccan Oil" because the term is merely descriptive. For example, in the office action dated March 29, 2008 for Registration 3,684,910, the examiner stated:

"The applicant must disclaim the descriptive wording "MOROCCAN OIL" apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). The wording is merely descriptive because it describes an ingredient in the goods. See attached evidence. The computerized printing format for the Trademark Official Gazette requires a standard form for a disclaimer. TMEP §1213.08(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use MOROCCAN OIL apart from the mark as shown.

In response to each office action for each of the above registrations, Respondent, argued that it has acquired distinctiveness pursuant to Section 2(f), and amended its application as such. Petitioner, YPGT, which uses its trademark, ROYAL MOROCCAN, has filed a cancellation on the basis that the term Moroccan Oil is 1) generic; 2) merely descriptive; 3) deceptively misdescriptive; 4) geographically misdescriptive descriptive; 5) primarily geographically descriptive; and 6) was acquired fraudulently.

Following the grant of its applications, Respondent has pursued and filed over 60 federal lawsuits on the primary basis of trademark infringement in connection with Respondent's federal registrations cited above. See **Exhibit A** showing each Notice of Suit filed by Respondent. To date, Petitioner is aware of only one instance in which a proceeding was brought forth before the Trademark Trial and Appeals Board ("TTAB") in an attempt to oppose or cancel any of the above cited registrations owned by Respondent.¹ However, that matter shortly settled prior to an Answer being filed, and no judgment was rendered regarding the validity of Respondent's trademark registrations.

Currently, Respondent has filed a lawsuit against Petitioner in federal court on the basis of trademark infringement for its use of ROYAL MOROCCAN. By filing its complaint, Respondent has inflated its wrongfully acquired trademark rights, and now essentially believes that it is entitled to the word "Moroccan" regardless of any other combination of words. Although, Petitioner clearly believes that no likelihood of confusion exists, the paramount concern is the validity of Respondent's marks and claim to the words "Moroccan oil". As such it is critical that this matter continue and not be suspended as Respondent will continue its serial filing of wrongful trademark infringement complaints in federal court. At its current rate, it is possible that Respondent, Moroccanoil, Inc. could file another 60 federal trademark infringement lawsuits within the next two years. Therefore, a validity determination of Respondent's trademarks would not only be dispositive in regards to Petitioner YPGT, but would also be a threshold matter to all future defendants that may use the term "Moroccan" in connection with its hair related goods and services. See *Kemin Industries, Inc. v. Watkins Products, Inc.*, 183 U.S.P.Q. 799 (D. Minn. 1974) (granting stay on grounds of judicial

¹ Primary One, LLC vs. Moroccanoil, Inc., Cancellation Proceeding No. 92053124.

economy, where PTO resolution would be faster and might eliminate need for further litigation in district court).

Additionally, Respondent's reference to the "Vogue Action" as discussed on pp. 3 of Respondent's Motion to Suspend, has no bearing on the Cancellation proceeding brought forth here by Petitioner, YPGT , as YPGT, its employees, partners, or agents, have absolutely no connection to the Vogue parties. Lastly, it is intended that a Motion to Suspend the federal matter, *Moroccanoil, Inc. v. Yari Golan, CV-11-01974-SJO (JEMx), Central District of California, Los Angeles* (the "Golan Matter") will be filed shortly.

II. ARGUMENT

A. The Cancellation Should Proceed Based on the Primary Jurisdiction Doctrine.

The TTAB should deny Respondent's request to stay, and exercise its discretion in order to permit the TTAB to resolve the issue of whether (1) "Moroccan Oil" is generic; or (2) is merely descriptive, geographically misdescriptive, deceptively misdescriptive, and primarily geographically descriptive, and thus a term that is not entitled to trademark protection; and (3) whether the mark was acquired by fraud. By doing so, the TTAB would exercise its inherent power to promote economy of judicial time and effort, or by invoking the "primary jurisdiction" doctrine, which "comes into play whenever enforcement of the claim requires the resolution of issues which . . . have been placed within the special competence of an administrative body." (D.I. 19 at 3-4); *Driving*

Force, Inc. v. Manpower, Inc., 498 F.Supp. 21, 24 (E.D. Pa. 1980); See also *Texace, Inc. v. Borda*, 383 F.2d 607, 608 (3rd Cir. 1967).

The TTAB regularly decides issues of genericism, merely descriptive, geographically misdescriptive, deceptively misdescriptive, and primarily geographically descriptive, and the separately determined issue of fraud against the USPTO as strictly put forth *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009). As such, an opinion from the TTAB would significantly expedite the Court's treatment of the issues presented. If the TTAB first determines any of the above issues, this decision would warrant dismissal of not only the Golan matter, but would have a decisive effect on future bullying lawsuit that would have inevitably been filed by Respondent, Moroccoanoil, Inc. A court has the power to enter a stay under the doctrine of primary jurisdiction. Application of the primary jurisdiction doctrine is appropriate when there is a need for an initial consideration of issues by an agency with specialized knowledge, and those issues have been placed before that agency by the parties. See *Consolidated Rail Corp. v. City of Dover*, 450 F.Supp. 966 (D.Del. 1978). In determining whether to apply the doctrine of primary jurisdiction, courts typically focus on whether the agency's decision could be dispositive of the district court action. See *American Bakeries Co.*, 650 F.Supp. 563 (D. Min 1986)(holding that "the case for permitting the PTO to proceed first is bolstered where the PTO adjudication might serve as a final disposition of the matter"); *Goya Foods v. Tropicana Prods. Inc.*, 846 F.2d 848 (2nd Cir. 1988)(holding "if a district court action involves only the issue of whether a mark is entitled to registration [(i.e., the same issue as was then before the TTAB)] . . . , the doctrine of primary jurisdiction might well be applicable"); *E & J Gallo Winery v. F & P S.p.A.*, 899 F.Supp. 465, 468 (E.D.

Cal. 1994)(holding that fact that issues raised in TTAB proceeding were “not dispositive” was the “most important” factor in denying a stay).

In this case, a determination that the term "Moroccan Oil" is generic, or, merely descriptive, geographically misdescriptive, deceptively misdescriptive, primarily geographically, and was acquired by fraud against the USPTO, if adopted by the Court, would be dispositive of all of Respondent's claims, as each claim depends on Respondent owning a valid trademark. Additionally, because the TTAB is often called to determine whether a commonly-used word or term is generic, the issue of genericism is within the special expertise of the TTAB. See *Continental Airlines, Inc. v. United Air Line, Inc.* 53 U.S.P.Q.2d 1385 (TTAB 2000)(holding that the term "e-ticket" for computerized reservation and ticketing services is generic); *In re 3Com Corp.*, No. 74/495,184, 2000 WL 1182872 (TTAB 2000)(holding that "ATMlink" for computer network components was generic).

B. The Cancellation Should Proceed to Promote the Efficient and Fair Resolution of Disputed Issues

A primary basis in which Court's base their decision to stay an action is whether it is in the interests of efficient and fair resolution of the disputed issues. See *Texaco, Inc. v. Borda*, 383 F.2d 607, 608 (3rd Cir. 1967). In the Golan Matter federal litigation, both plaintiff and defendant have conducted very little discovery although the discovery cut-off has already passed. No depositions have taken place for either parties, nor has there been any meaningful written discovery by the parties. Further, Petitioner, YPGT, has just recently been named as a party to the Golan Matter, and has yet to be served. The Golan Matter parties stipulated to continue all discovery and motion dates to allow for the

meaningful written discovery and depositions to aid in the resolution of the disputed issues, including the invalidity of all the Respondent's registrations using the phrase "Moroccan Oil".

However, on March 22, 2012, the judge in the Golan Matter denied the request to extend discovery, further the discovery cut-off has passed on March 26, 2012, and consequently no further discovery on any issue in the Golan Matter will take place. See **Exhibit B**. If a suspension is granted to Respondent, there will be no opportunity for the parties to efficiently and fairly engage in the issues of invalidity of the Respondent's trademark registrations. Accordingly, the cancellation proceeding before the TTAB will provide the only forum for the parties to resolve the disputed issues.

CONCLUSION

Accordingly, Petitioner respectfully requests the Board to deny the Respondent's request for suspension of this cancellation proceeding.

Respectfully submitted,

COHEN IP LAW GROUP, P.C.

Dated: March 29, 2012

By: /Michael N. Cohen/
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Attorneys for Petitioner
Y.P. GOLAN TRADE LTD.

CERTIFICATE OF SERVICE

I hereby certify that a copy of this document is being served on March 29, 2012 by first class U.S. mail to its attorney William C. Conkle, Conkle Kremer & Engel, 3130 Wilshire Blvd., Ste 500, Santa Monica, California 90403.

/Michael N. Cohen/
Michael N. Cohen

EXHIBIT A

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2012-03-19 - Notice Of Suit

2012-03-19 - Notice Of Suit

2012-03-19 - Notice Of Suit

2012-03-16 - Notice Of Suit

2012-03-16 - Notice Of Suit

2012-02-16 - Notice Of Suit

2012-02-13 - Notice Of Suit

2012-01-25 - Notice Of Suit

2012-01-20 - Cancellation Instituted No. 999999

2011-12-22 - Notice Of Suit

2011-11-09 - Notice Of Suit

2011-11-09 - Notice Of Suit

2011-11-09 - Notice Of Suit

2011-10-12 - Notice Of Suit

2011-10-12 - Notice Of Suit

2011-09-29 - Notice Of Suit

2011-09-26 - Notice Of Suit

2011-09-23 - Notice Of Suit

2011-09-23 - Notice Of Suit

2011-09-23 - Notice Of Suit

2011-09-22 - Notice Of Suit

2011-09-12 - Notice Of Suit

2011-09-12 - Notice Of Suit

2011-09-09 - Notice Of Suit

2011-09-09 - Notice Of Suit

2011-08-17 - Notice Of Suit

2011-08-17 - Notice Of Suit

2011-08-17 - Notice Of Suit

2011-08-16 - Notice Of Suit

2011-08-11 - Notice Of Suit

2011-07-20 - Notice Of Suit

2011-07-20 - Notice Of Suit

2011-07-18 - Notice Of Suit

2011-07-18 - Notice Of Suit

2011-07-18 - Notice Of Suit

2011-07-18 - Notice Of Suit

2011-07-18 - Notice Of Suit

2011-07-18 - Notice Of Suit

2011-07-18 - Notice Of Suit

2011-07-14 - Notice Of Suit

2011-07-14 - Notice Of Suit

2011-07-12 - Notice Of Suit

2011-06-15 - Notice Of Suit

2011-06-15 - Notice Of Suit

2011-06-14 - Notice Of Suit

2011-05-25 - Notice Of Suit

2011-05-17 - Notice Of Suit

2011-05-17 - Notice Of Suit

2011-05-12 - Notice Of Suit

2011-05-11 - Notice Of Suit

2011-05-11 - Notice Of Suit

2011-05-06 - Notice Of Suit

2011-05-06 - Notice Of Suit

2011-05-04 - Notice Of Suit

2011-05-04 - Notice Of Suit

2011-05-02 - TTAB Release Case To Trademarks

2011-05-02 - Cancellation terminated for Proceeding

2011-05-02 - Cancellation dismissed for Proceeding

2011-04-26 - Notice Of Suit

2011-04-26 - Notice Of Suit

2011-04-26 - Notice Of Suit

2011-04-21 - Notice Of Suit

2011-03-30 - Applicant/Correspondence Changes (Non-Responsive) Entered

2011-03-30 - TEAS Change Of Owner Address Received

2011-03-22 - Notice Of Suit

2011-03-21 - Notice Of Suit

2011-03-21 - Notice Of Suit

2011-03-08 - Notice Of Suit

2011-02-24 - Notice Of Suit

2011-02-24 - Notice Of Suit

2011-02-23 - Notice Of Suit

2011-02-09 - Notice Of Suit

2011-01-14 - Notice Of Suit

2011-01-03 - Notice Of Suit

2010-10-22 - Notice Of Suit

2010-10-12 - Cancellation Instituted No. 999999

2010-08-31 - Notice Of Suit

2010-08-17 - Notice Of Suit

2010-08-17 - Notice Of Suit

2010-08-17 - Notice Of Suit

2010-08-10 - Notice Of Suit

2010-08-10 - Notice Of Suit

2010-08-10 - Notice Of Suit

2010-08-10 - Notice Of Suit

2010-08-03 - Notice Of Suit

2010-08-03 - Notice Of Suit

2010-05-14 - Notice Of Suit

2010-04-19 - Notice Of Suit

2010-03-30 - Notice Of Suit

2010-03-05 - Notice Of Suit

2010-01-28 - Notice Of Suit

2009-09-01 - Notice Of Suit

2009-05-21 - Notice Of Suit

2009-05-15 - Notice Of Suit

2009-02-03 - Attorney Revoked And/Or Appointed

2009-02-03 - TEAS Revoke/Appoint Attorney Received

2008-08-20 - Notice Of Suit

2008-08-18 - Applicant/Correspondence Changes (Non-Responsive) Entered

2008-08-18 - TEAS Change Of Owner Address Received

2008-08-13 - Automatic Update Of Assignment Of Ownership

2008-08-05 - Registered - Principal Register

2008-05-20 - Published for opposition

2008-04-30 - Notice of publication

2008-04-14 - Examiner's amendment mailed

2008-04-14 - Law Office Publication Review Completed

2008-04-14 - Approved for Pub - Principal Register (Initial exam)

2008-04-14 - Examiner's Amendment Entered

2008-04-14 - Examiners Amendment - Written

2008-04-07 - Amendment to Use approved

2008-03-05 - Amendment To Use Processing Complete

2008-03-05 - Use Amendment Filed

2008-03-04 - TEAS Amendment of Use Received

2008-02-25 - Non-final action mailed

2008-02-23 - Non-Final Action Written

2008-01-31 - Amendment From Applicant Entered

2008-01-31 - Communication received from applicant

2008-01-31 - Assigned To LIE

2007-12-20 - PAPER RECEIVED

2007-06-19 - Non-final action mailed

2007-06-19 - Non-Final Action Written

2007-06-18 - Assigned To Examiner

2007-03-09 - Notice Of Pseudo Mark Mailed

2007-03-08 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Mark D. Kremer

Correspondent

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EXHIBIT B

DENIED
BY ORDER OF THE COURT

ALL DATES SET REMAIN. 3/22/12
SJO

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION

MOROCCANOIL, INC., a California
corporation,

Plaintiff,

v.

YAIR GOLAN, an individual; GIDON
ZAFT, an individual; ROYAL
MOROCCAN, CORP. a Florida
corporation; Y.P. GOLAN TRADE,
LTD. an Israeli entity; and DOES 1
through 10 inclusive,

Defendants.

CASE No. CV 11-01974 SJO (JEMx)

**[PROPOSED] ORDER TO EXTEND
ALL SCHEDULED DATES**

Assigned for all purposes to:
Honorable S. James Otero
Courtroom No. 1

Trial Date: July 10, 2012

1 Based upon the stipulation between Plaintiff MoroccanOil, Inc. and Defendant
2 Yair Golan the Court makes the following order:

3
4 IT IS HEREBY ORDERED that the following dates in this case be extended as
5 follows:

6

7 Discovery Cut-off	September 28, 2012
8 Motion Hearing Cut-off	November 16, 2012
9 Pretrial Conference	January 7, 2013
10 Jury Trial Date	January 15, 2013

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12 Dated: _____

Honorable S. James Otero
Judge, United States District Court

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15 Respectfully Submitted:

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18 s/Kevin R. Keegan/

19 Kevin R. Keegan
20 Conkle, Kremer & Engel PLC
21 3130 Wilshire Boulevard, Suite 500
22 Attorney for Plaintiff MoroccanOil, Inc.
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